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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 17

Application Number: 09/629,370
Filing Date: July 31, 2000
Appellant(s): SULAK ET AL.

James C. Scott
<u>For Appellant</u>

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/14/04.

(1)   ***Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

(2)   ***Related Appeals and Interferences***

A statement identifying the related appeals and interferences, which will directly affect or be

directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3)   ***Status of Claims***

The statement of the status of the claims contained in the brief is correct.

(4)   ***Status of Amendments***

The appellant's statement of the status of amendments in response to the office action

contained in the brief is correct.

(5)   ***Summary of Invention***

The summary of invention contained in the brief is correct.

(6)   ***Issues***

The appellant's statement of the issues in the brief is correct.

(7)   Grouping of Claims

The appellant's grouping of the claims is correct.

(8)   Claims Appealed

The copy of the appealed claims contained in Appendix A to the brief is correct.

(9)   Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims

under appeal.

6311214 B1   10-2001   Rhoads

5742768   4-1998   Gennaro et al.

5552994   9-1996   Cannon et al.

(10)   Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis

for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 10-12 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U. S.

Patent No. 6,311,214 B1 (Rhoads).

Referring to claim 10, Rhoads discloses means for creating, modifying and printing of a

printable product. Rhoads discloses using modifying a browser program, represented as the

website, where in the client computer uses this website/browser to edit the defining data for the

printable product. The Internet is the network used for accessing and displaying the data,

wherein the web server contains the data and the web page displayed on the client's computer, accesses the information from the server, wherein this acquisition has downloaded data defining a printable product. Rhoads discloses modifying and customizing the information to print. See column 10, lines 51-56 and lines 24-26.

Referring to claims 11 and 12, Rhoads discloses modifying means for manipulating any of the design elements, wherein the elements include text or graphics for customizing the printable products (column 10, lines 18-20).

(11)   Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5, 14-19 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads and U. S. Patent No. 5,742,768 (Gennaro et al.).

Referring to claim 1, Rhoads discloses a system for the creation of printable products on-line. The on-line system is represented in an Internet network, which is made of a client and server. Rhoads discloses the online acquisition of a greeting card, which suggests a user through a client accessing information from a website which is presented to the user, the data that is stored in a server. Rhoads discloses presenting to the user, a variety of simple editing tools for customizing the greeting cards, thereby suggesting the server presenting data stored in the server

that is data defining a plurality of printable products with design elements for modifying and

assembling the product. Rhoads suggests with the website, a user accessing the server with a

client for defining the data, wherein accessing the information through the website, suggests

downloading the data to the client. Rhoads also suggests a printer operatively coupled with a

client computer, wherein the printable product customized at a website, can be printed at the

user's computer. See column 10, lines 51-56 and lines 24-26. Rhoads, discloses the use of

accessing websites to create the customized the printable products, but does not discuss the

details of this method, wherein a first program is downloaded to provide users with the

modifying data for the printable products, as recited in the claims. Gennaro discloses another

website system with a server and clients, wherein a first program, represented as the applet is

downloaded from the server to the client's computer, in order to display a menu wherein a user

may manipulate or customize the web page based on their desires (column 3, lines 58-64). It

would have been obvious for one skilled in the art, at the time of the invention to learn from

Gennaro to implement a first program used to modify the printable product. Rhoads discloses

using a website and accessing "customizing" information from a server, wherein this information

is downloaded to the client and used for customizing the printable product. Such data would

include a first program, which represented as an applet would allow the user to manipulate and

carry out the functions needed to customize only when the user has made a request to customize,

in reference to the website they have accessed, which allows for mobility. Hence, one skilled in

the art, would have been motivated to learn from Gennaro to specifically indicate that the

information accessed from the server to be displayed on a website, include a first program which

would be downloaded to the client's computer and used for displaying and customizing the

defining functions for a printable product.

Referring to claims 2 and 15, Rhoads and Gennaro discloses that the plurality of printable

products includes greeting cards (Rhoads, column 10, lines 51-53).

Referring to claims 3 and 16, Rhoads and Gennaro discloses a browser program, as is

used for displaying websites, accessing the web server, with the first program, represented as the

first program enhancing the functionality of the browser program (Gennaro, Figure 1, column 3,

lines 38-42).

Referring to claims 4 and 17, Rhoads and Gennaro discloses that product defining data

for customizing the product is downloaded to the client from the server, wherein the web applet,

represented as the first program downloaded, can download the information for customizing the

product (Rhoads, column 10, lines 51-56).

Referring to claims 5 and 18, Rhoads and Gennaro disclose that the defining data for the

personalization of the product includes text elements (Rhoads, column 10, lines 18-20).

Referring to claim 14, Rhoads discloses a system for the creation of printable products

on-line. The on-line system is represented in an Internet network, which is made of a client and

server. Rhoads discloses the online acquisition of a greeting card, which suggests a user through

a client accessing information from a website which is presented to the user, the data that is

stored in a server. Rhoads discloses presenting to the user, a variety of simple editing tools for

customizing the greeting cards, thereby suggesting the server presenting data stored in the server

that is data defining a plurality of printable products with design elements for modifying and

assembling the product. Rhoads suggests with the website, a user accessing the server with a client for defining the data, wherein accessing the information through the website, suggests downloading the data to the client. Rhoads disclosure of customizing within the website suggests that assembling and modifying, customizing occur with the web browser on the client computer. Rhoads also suggests a printer operatively coupled with a client computer, wherein the printable product customized at a website, can be printed at the user's computer. See column 10, lines 51-56 and lines 24-26. Rhoads, discloses the use of accessing websites to create the customized the printable products, but does not discuss the details of this method, wherein a first program is downloaded to provide users with the modifying data for the printable products, as recited in the claims. Gennaro discloses another website system with a server and clients, wherein a first program, represented as the applet is downloaded from the server to the client's computer, in order to display a menu wherein a user may manipulate or customize the web page based on their desires (column 3, lines 58-64). It would have been obvious for one skilled in the art, at the time of the invention to learn from Gennaro to implement a first program used to modify the printable product. Rhoads discloses using a website and accessing "customizing" information from a server, wherein this information is downloaded to the client and used for customizing the printable product. Such data would include a first program, which represented as an applet would allow the user to manipulate and carry out the functions needed to customize only when the user has made a request to customize, in reference to the website they have accessed, which allows for mobility. Hence, one skilled in the art, would have been motivated to learn from Gennaro to specifically indicate that the information accessed from the server to be

displayed on a website, include a first program which would be downloaded to the client's computer and used for displaying and customizing the defining functions for a printable product.

Referring to claim 19, Rhoads and Gennaro that the applet downloaded into the browser enables the building of menus which can be used by Rhoads within the browser to access customization information for customizing printable products for printing (Rhoads, column 10, lines 51-56; Gennaro, column 3, lines 58-64).

Referring to claims 22 and 23, Rhoads discloses an Internet network system, wherein the user accesses the customization information for greeting cards through a web site. Rhoads, thereby disclosing this online access, suggests the presence of a web server, a client computer, wherein the user can communicate and access information from the web server to display the information. A web browser which allows for the website to be displayed on the client computer. Rhoads suggests with the website, a user accessing the server with a client for defining the data, wherein accessing the information through the website, suggests downloading the data to the client. Rhoads disclosure of customizing within the website suggests that assembling and modifying, customizing occur with the web browser on the client computer. Rhoads also suggests a printer operatively coupled with a client computer, wherein the printable product customized at a website, can be printed at the user's computer. See column 10, lines 51-56 and lines 24-26. Rhoads, discloses the use of accessing websites to create the customized the printable products, but does not discuss the details of this method, wherein a plug-in program is downloaded to provide users with the modifying data for the printable products, as recited in the claims. Rhoads also does not explicitly state a database stores the information, which is stored

and accessed for customizing the display for customizing the printable product, as, recited in the

claims. Gennaro discloses another website system with a server and clients, wherein a plug-in

program, represented as the applet is downloaded from the server to the client's computer, in

order to display a menu wherein a user may manipulate or customize the web page based on their

desires (column 3, lines 58-64). Gennaro also discloses a database for storing any information

that needs to be accessed by the client from the server, with the database couple to the web

server or hosting system (column 3, lines 26-33). It would have been obvious for one skilled in

the art, at the time of the invention to learn from Gennaro to implement a plug-in program used

to modify the printable product and database storing the information that is needed. Rhoads

discloses using a website and accessing "customizing" information from a server, wherein this

information is downloaded to the client and used for customizing the printable product. Such

data would include a plug-in program, which represented as an applet would allow the user to

manipulate and carry out the functions needed to customize only when the user has made a

request to customize, in reference to the website they have accessed, which allows for mobility.

With specific defining data, there must be some structured storage means which would make it

easily accessible to get the defining data, and the host system has disclosed in Gennaro has such

a database which stores any data that is needed for customizing the web page. Hence, one

skilled in the art, would have been motivated to learn from Gennaro to specifically indicate that

the information accessed from the server to be displayed on a website, include a plug-in program

and defining data stored in a database coupled to the server/host system, which would be

downloaded to the client's computer and used for displaying and customizing the defining

functions for a printable product.

Referring to claim 24, Rhoads and Gennaro disclose the storing of data, wherein the

storage devices used in their invention including remote storage device, a web server, a personal

or client computer and a storage medium, all being needed and are inherently part of an Internet

network (column 3, lines 22-32).

Referring to claim 25, Rhoads and Gennaro disclose a means through which the plug-in

program of Gennaro allow the user to access information from an external source, such as

storage devices found in a host system that are not in the client/user's computer, thereby making

it external, and this information which are design elements for the web page is created based on

actions by the user, wherein a user may make certain choices which would initiate the creation of

new web page design elements (Gennaro, column 3, lines 27-32 and column 4, lines 19-29).

Claims 13 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads

and U. S. Patent No. 5,552,994 (Cannon et al.).

Referring to claim 13, Rhoads does not disclose customizing the layout of the printable

product, as recited in the claims. Cannon discloses that assembling of printing data also includes

division into panels for anticipating printing in a desired format (column 12, lines 3-5). It would

have been obvious for one skilled in the art, at the time of the invention to learn from Cannon for

methods for explicitly stating printing formats for the printable products. Rhoads does customize

and print a product based on the needs of a user, since printing is involved, there must be some

specific formatting means, which would allow the users to choose the layout they desire before

printing. Cannon is a product customizing system, which allows for customizing and printing much like Rhoads. Hence, one skilled in the art would have been motivated to learn from Cannon to implement specific formatting layout means for printing.

Referring to claim 26, Rhoads discloses the storing of data, wherein the storage devices used in their invention including remote storage device, a personal or client computer and a storage medium, all being needed and are inherently part of an Internet network. But Rhoads does not disclose a portable storage medium, as recited in the claims. Cannon discloses a portable storage medium, represented as the CD of Figure 3 (reference number 33). It would have been obvious for one skilled in the art, at the time of the invention to learn from Cannon to implement a portable storage medium. It is well known that CDs are used for accessing information; wherein data this is stored can be accessed, while also giving mobility to the information, wherein the medium is portable. Portability gives much more flexibility, allowing the users to do much more with data that can be used in various computers without relying on a network. Hence, one skilled in the art would have been motivated to learn from Cannon and implement a portable storage medium.

Claims 8-9 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads and Gennaro, and further in view of Cannon.

Referring to claims 8 and 20, Rhoads and Gennaro do not disclose customizing the layout of the printable product, as recited in the claims. Cannon discloses that assembling of printing data also includes division into panels for anticipating printing in a desired format (column 12, lines 3-5). It would have been obvious for one skilled in the art, at the time of the invention to

learn from Cannon for methods for explicitly stating printing formats for the printable products.

Rhoads and Gennaro do customize and print a product based on the needs of a user, since

printing is involved, there must be some specific formatting means, which would allow the users

to choose the layout they desire before printing. Cannon is a product customizing system, which

allows for customizing and printing much like Rhoads and Gennaro. Hence, one skilled in the

art would have been motivated to learn from Cannon to implement specific formatting layout

means for printing.

Referring to claims 9 and 21, Rhoads and Gennaro do not disclose the specifics of

how the printable product is customized or modified, as recited in the claims. Cannon

discloses that modification includes modifying font, color and position within a panel

(column 11, lines 50-60). It would have been obvious for one skilled in the art, at the

time of the invention to learn from Cannon for methods for the specifics of customizing

the printable products. Rhoads and Gennaro do customize and print a product based on

the needs of a user, and since there is customization, it is inherent that some specific

actions would be taken by the users to customize the printable product. Cannon is a

product customizing system, which allows for customizing and printing much like

Rhoads and Gennaro, but additionally discusses the specific means through which a user

can customize the product. Hence, one skilled in the art would have been motivated to

learn from Cannon to implement specific formatting means for customizing the printable

product.

(12)   Response to Arguments

With respect to Applicant's arguments that Rhoads does not disclose modifying a browser program based on the disclosure of modifications to a web page. Web pages are displayed through browser programs, wherein the web pages are part of this browser program. As seen by the explanation within the arguments itself, the web browser program allows for the retrieval and displaying of web pages, wherein any data that is part of these web pages would therein be part of the web browser program. The web pages and the web browser program are all entailed into one, wherein changes to a web pages or modifications to a web page can be interpreted as modifications to a web browser program. The web pages that are being modified are part of the web browser program itself, wherein the display of these web pages within these web browser programs at which point the modifications are being made by the user, would inherently be interpreted as making modifications to the program itself of which the displayed web pages are a part of. Furthermore, Applicant within the arguments has stated that customization of a web site is merely a modification of what is to be retrieved and displayed by the web browser, wherein it is precisely this modification of the web page, wherein once the web page has been modified, the web page being a part of this web browser program during the modification process, and wherein the web browser has clearly played a role during this modification process and furthermore in displaying this modified data, thereby showing that the web browser by displaying this modified data is inherently a part of the web page and is affected by any changes made to the web page. The interpretation used relies on the concept of wherein just simply by the web browser displaying the data that is being modified, wherein the web page is displayed within this browser program, and is being modified and the web browser program is

displaying this web page during this modification process implies that the web browser is also modified.

With respect to Applicant's arguments that Rhoads is silent about modifying the browser program to perform such modifications within the browser program and about modifying the downloaded data defining the decorative designs to appear on the printable products. Rhoads states downloading data wherein this downloaded data includes function tools that are added to the web browser program wherein allowing the user to customize the data needed for the greeting cards (column 10, lines 24-27). Furthermore, Rhoads has disclosed the downloading of the information needed wherein this information is then presented to the user to allow the user to customize the greetings, all done on the web page, which is displayed within the web browser program, thereby showing that the defining of the data is done within the browser program (column 10, lines 51-54).

With respect to Applicant's arguments that the applet disclosed in Gennaro is different from first program to be downloaded disclosed in the present claims. Applicant argues that there is no mention of downloading and installing a first program in Gennaro. But the present claims lack the feature of installation and any methods involved in installing any programs. Rhoads has clearly disclosed the downloading of data used in customizing and modified components of a web page, displayed within a browser program, wherein tools and customization data is downloaded to allow the user to customize greetings. Gennaro goes further in discussing the use of plug-ins or applets to be downloaded and used for providing enhanced data and functionality, wherein this enhanced data and functionality when combined would be represented as the

customization data of Rhoads used for customizing the greetings. Gennaro allows for the necessary data to be packaged into an applet program that can be downloaded. Applicant's arguments concerning the role of plug-ins in relation to web pages clearly define the role of applets as stated in Gennaro. Gennaro clearly states that the applet is downloaded to the web browser program to enhance the functionality of the web browser, wherein the applets can provide functionality to the web pages within these browsers (column 1, lines 38-41), wherein Gennaro clearly discloses the role of the web browser in executing this applet and thereby providing more evidence of the role of web browsers in relation to functionality of the web pages itself.

With respect to Applicant's arguments that the applet of Gennaro fails to provide the user with the ability to modify data defining decorative designs. The discussion in Gennaro includes a general concept of the idea of applets and how they are beneficial in providing enhanced functionality to a web browser. Gennaro may not specifically disclose using these applets to provide customization data for creating greetings but the general discussion of the advantages of an applet providing functionality to a web browser therein provides good motivation for Rhoads who would gain from creating a package referred to as an applet that would include all the customization tools and data, that can be downloaded to provide customization data to the user for creating greeting cards. The combination of Rhoads and Gennaro with the proper motivation for better functionality and the teachings in Gennaro allow for the concept of creating customized online data wherein a program is downloaded containing this data and used in the user's computer to customize and print to the user's printer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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